Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN BUENDIA,
PATRICK ROUSSEL, and
MICHEL VIVAT

Appeal No. 1997-1767
Application No. 08/442,959

ON BRIEF

Before WALTZ, LIEBERMAN, and DELMENDO, *Administrative Patent Judges*.

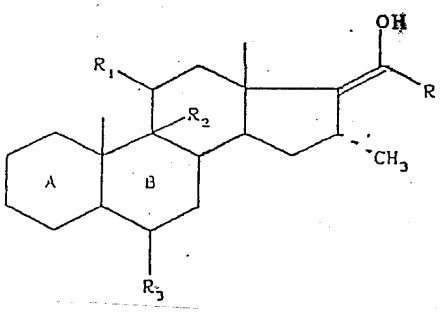
DELMENDO, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 11 and 12, which are the only claims remaining in the application. These claims were amended subsequent to the final rejection in the

amendment filed June 11, 1996 (Paper No. 8), which the examiner entered (Advisory Action; Paper No. 10).

According to the appellants, the invention is directed to novel compounds of the recited Formula III (brief, page 2). These compounds, in turn, are useful intermediates for the preparation of 16"-methyl-steroids of Formula I, which are known to possess anti-inflammatory activity (*id*.; specification, pages 3 and 11).



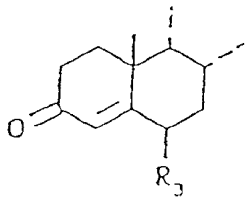
III

Claim 11 is illustrative of the claims on appeal and is reproduced below:[1]

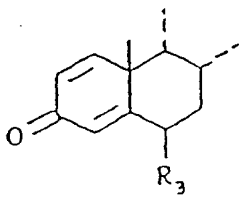
11. A compound of the formula

[1] We note that the copy of claim 11 as it appears in the appendix to the appeal brief does not correspond identically to actual claim 11 as it appears here and in the Amendment filed January 16, 1996.

wherein the A and B rings represent a group



wherein the ketone function in position 3 is optionally protected in the form of a ketal, thioketal, hemithioketal or enol ether or



wherein R is methyl or -CH_2-OR', R'is hydrogen or a protecting ether or ester group and R_1 and R_2 form together a second bond, or R_1, and R_2 form together $-epoxide,
or R_1 is hydrogen, ketone or hydroxy in "- or $-position, free or protected in the form of an ether or ester and R_2 is "-hydroxy, or R_1 is $-hydroxy, free or protected in the form of an ether or ester and R_2 is a "-fluorine or $-bromine, and R_3 is hydrogen, fluorine, "-methyl or $-methyl.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Chem. Abstracts, Vol. 94, 192566 (1981)(CA '566)
Chem. Abstracts, Vol. 88, 170389 (1978)(CA '389)

The examiner has also cited the following document "for evidentiary purposes only" (answer, page 3):

March, J.,(March), *Advanced Organic Chemistry*, 66-68 (3rd ed., New York, John Wiley & Sons, 1985).

The grounds of rejection presented for our review in this appeal are as follows:

Claims 11 and 12 stand rejected under 35 U.S.C. § 102(b) as anticipated by CA ‘389; and

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over CA ‘566.

We have carefully reviewed the entire record, including all of the arguments and evidence presented by the examiner and by the appellants. Our review leads us to conclude that the aforementioned rejections are not well founded. Accordingly, we reverse.[2]

OPINION

We consider first the examiner’s rejection under 35 U.S.C. § 102(b) over CA ‘389. The examiner states that CA ‘389 discloses “the keto form” of the appellants’ claimed compound (answer, page 3). According to the examiner, “the enol form” (i.e., the appellants’ claimed compound) exists inherently

[2] We hasten to point out that our decision is confined to the rejections based solely on the teachings of CA ‘389 and CA ‘566, *not* the underlying patent documents identified therein.

together with the "keto form" described in the prior art (*id*.). The examiner further explains her position as follows:

> March discloses that with double bonds the enol may be the **predominant** form, but it is well-recognized to one of ordinary skill in the art that a tautomer is a steady-state, reversible equilibrium, that the keto and enol forms are each in equilibrium with the other and that while the equilibrium can be to the left, that is predominantly to the keto form, *it does not have to be*. Furthermore, the extent of enolization is affected by solvent, concentration and temperature. [Bolded emphasis original; italics added; answer, p. 5.]

"'To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.'" *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999)(quoting *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)); *accord Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1995).

It is well settled, however, that inherency may not be established by probabilities or possibilities (i.e., it is insufficient to merely show that a certain thing *may* result from a given set of circumstances). *Mehl/Biophile*, 192 F.3d

at 1365, 52 USPQ2d at 1305; *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *Hansgirg v. Kemmer*, 102 F.2d 212, 214,
40 USPQ 665, 667 (CCPA 1939). Thus, under the principles of inherency, a prior art reference anticipates a claim only if it *necessarily* includes the claim limitation in question. *Mehl/Biophile*, 192 F.3d at 1365, 52 USPQ2d at 1305 (citing *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986)).

In the case before us, the relied upon reference (March) merely describes keto-enol tautomerism in general terms. Nowhere does March state that *all* keto-containing compounds, much less the compounds described in CA '389, *necessarily* exist in admixture with the corresponding enol-containing compound. To the contrary, we find that March suggests exactly the opposite. Specifically, March indicates the enol content of CH_3COOEt as "No enol found - Less than 1 part in 10 million" (Table 1, page 67) and further states that "the extent of enolization is greatly affected by solvent, concentration, and temperature" (page 67). Here, the examiner

has not provided the requisite factual basis upon which to assert that the enol form would *necessarily* be present in the keto-containing compound described in CA '389.

Since the examiner has not met her initial burden of establishing a *prima facie* case of unpatentability,[3] we cannot sustain the examiner's rejection of claims 11 and 12 under 35 U.S.C. § 102(b). It follows then that we need not consider the sufficiency of the declaration of Dr. Catherine Lang filed June 11, 1996.

The examiner's rejection of claims 11 and 12 under 35 U.S.C. § 103(a) as unpatentable over CA '566 is reversible for reasons analogous to those discussed above. Again, the examiner has taken the position that CA '566 "discloses the keto form of the instant compound"[4] and that the enol form would exist inherently together with the keto compound (answer, page 4).

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[3] *See, e.g., In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

[4] The examiner also acknowledges that the compound described in CA '566 differs from the appellants' claimed compound in the presence of chlorine at the "C-7" [sic, 6] position (answer, page 4).

As we discussed above, however, we find that the examiner has not provided the requisite factual basis upon which to assert that the enol form would *necessarily* be present in the keto-containing compound described in CA '566. Accordingly, the examiner has not met her initial burden of proof. Consequently, as in the rejection based on CA '389, we are not compelled to consider the sufficiency of the declaration of Dr. Lang.

In summary, the examiner's rejection of claims 11 and 12 under 35 U.S.C. § 102(b) as anticipated by CA '389 and the rejection of claims 11 and 12 under 35 U.S.C. § 103(a) as unpatentable over CA '566 are reversed.

The decision of the examiner is reversed.

REVERSED

THOMAS A. WALTZ Administrative Patent Judge	)
PAUL LIEBERMAN Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
ROMULO H. DELMENDO Administrative Patent Judge	)

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CHARLES A. MUSERLIAN
BIERMAN AND MUSERLIAN
600 THIRD AVENUE
NEW YORK, NY 10016

RHD/dal